

REMARKS

Claims 1, 3–6, 13, 14 and 16–28 are pending in the application, with claims 1, 13, 17 and 25 being independent.

Claims 1, 14, 17-18, 23 and 25 are rejected under 35 U.S.C. §103(a) as being unpatentable over Natarajan et al. (US 7,293,106, hereinafter Natarajan) in view of Shah et al. (US 2003/0208572, hereinafter Shah).

Claims 3–6, 19–22 and 26-28 are rejected under 35 U.S.C. §103(a) as being unpatentable over Natarajan in view of Shah in further view of Bertin et al., U.S. Patent No. 6,400,681 (hereinafter “Bertin”).

Claims 13, 16 and 24 are allowed.

Each of the various rejections and objections are overcome by amendments that are made to the specification, drawing, and/or claims, as well as, or in the alternative, by various arguments that are presented.

Entry of this Amendment is proper under 37 CFR §1.116 since the amendment: (a) places the application in condition for allowance for the reasons discussed herein; (b) does not raise any new issue requiring further search and/or consideration since the amendments amplify issues previously discussed throughout prosecution; (c) satisfies a requirement of form asserted in the previous Office Action; (d) does not present any additional claims without canceling a corresponding number of finally rejected claims; or (e) places the application in better form for appeal, should an appeal be necessary. The amendment is necessary and was not earlier presented because it is made in response to arguments raised in the final rejection. Entry of the amendment is thus respectfully requested.

Any amendments to any claim for reasons other than as expressly recited herein as being for the purpose of distinguishing such claim from known prior art are not being made with an intent to change in any way the literal scope of such claims or the range of equivalents for such claims. They are being made simply to present language that is better in conformance with the form requirements of Title 35 of the United States Code or are simply clearer and easier to understand than the originally presented language. Any amendments to any claim expressly made in order to distinguish such claim from known prior art are being made only with an intent to change the literal scope of such

claim in the most minimal way, i.e., simply to avoid the prior art in a way that leaves the claim novel and not obvious in view of the cited prior art, and no equivalent of any subject matter remaining in the claim is intended to be surrendered.

Also, because a dependent claim inherently includes the recitations of the claim or chain of claims from which it depends, it is submitted that the scope and content of any dependent claims that have been herein rewritten in independent form is exactly the same as the scope and content of those claims prior to having been rewritten in independent form. That is, although by convention such rewritten claims are labeled herein as having been "amended," it is submitted that only the format, and not the content, of these claims has been changed. This is true whether a dependent claim has been rewritten to expressly include the limitations of those claims on which it formerly depended or whether an independent claim has been rewritten to include the limitations of claims that previously depended from it. Thus, by such rewriting, no equivalent of any subject matter of the original dependent claim is intended to be surrendered. If the Examiner is of a different view, he is respectfully requested to so indicate.

Rejection Under 35 U.S.C. §103

The Examiner bears the initial burden of establishing a prima facie case of obviousness. See MPEP § 2141. Establishing a prima facie case of obviousness begins with first resolving the factual inquiries of *Graham v. John Deere Co.* 383 U.S. 1 (1966). The factual inquiries are as follows:

- (A) determining the scope and content of the prior art;
- (B) ascertaining the differences between the claimed invention and the prior art;
- (C) resolving the level of ordinary skill in the art; and
- (D) considering any objective indicia of nonobviousness.

Once the *Graham* factual inquiries are resolved, the Examiner must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. The key to supporting a rejection under 35 U.S.C. §103 is the clear articulation of the reasons why the claimed invention would have been obvious. The analysis supporting such a rejection must be explicit. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated

reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006), cited with approval in *KSR Int'l Co. v. Teleflex, Inc.*, 126 S. Ct. 2965 (2006); see also MPEP §2141.

According to MPEP §2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art" (*quoting, In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). In addition, to establish a *prima facie* case of obviousness the prior art reference (or references when combined) must teach or suggest all elements of the subject claim. *In re Wada*, 2007-3733 (BPAI Jan. 14, 2008) (*citing, CMFT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed.Cir. 2003)).

Claims 1, 14, 17-18, 23 and 25

Applicants' representatives sincerely appreciate the courtesies extended by the Examiner in conferring with the representatives in order to expedite prosecution of instant application.

Pursuant to the Examiner's suggestions, independent claims 1, 17 and 25 are amended to better clarify the claimed embodiments and further distinguish same over the prior art.

Claims 1, 14, 17-18, 23 and 25 are rejected under 35 U.S.C. §103(a) as being unpatentable over Natarajan in view of Shah. The rejection is traversed.

Natarajan and Shah singly or in any permissible combination fail to teach or suggest all elements of amended independent claim 1. Specifically, the Examiner acknowledges that Natarajan does not teach the notification signal being indicative of the existence of the established communication path in the network. (See Office Action, page 7). The Examiner then cites Shah at para. 0052 and 0058 for bridging the substantial gap between the claimed feature and Natarajan. Shah too is directed towards establishing a path as opposed to management function after a path is established. Shah fails to bridge the substantial gap between Natarajan and Applicant's amended claim 1.

Further, in rejecting claim 1, the Examiner failed to establish a *prima facie* case of obviousness, because there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l v. Teleflex, Inc.* 127 S. Ct. 1741 (2007) (*quoting In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). The

Examiner attempted to provide a reason to combine the prior art in the fashion claimed, because the claimed subject matter cannot be fairly characterized as involving the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement. However, the Examiner fails to provide some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness; the statement is merely conclusory. Accordingly, the Examiner's burden in making factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966) is not met.

Further, the motivation as articulated by the Examiner is hopelessly deficient. The Examiner articulates the result of modifying the references, to wit,

“in order to clients to easily become aware of dynamic topology changes, including, for example, the creation of new paths when links and switched are inserted into the switched fabric data network, and the destruction of existing data paths when links and switches are removed from the same switched fabric data network,” (See Office Action, page 7)

but fails to explicate why an artisan of ordinary skill in the art would be motivated to perform said modifications.

Because Natarajan and Shah singly or in any permissible combination fail to teach or suggest all elements of Applicant's independent claim 1, Applicant's independent claim 1 is allowable under 35 U.S.C. §103(a) over Natarajan in view of Shah.

As articulated above with respect to amended claim 1, Natarajan in view of Shah fails to teach all elements of amended independent claim 17 as required under 35 U.S.C. §103 for establishing a *prima facie* showing of obviousness.

Independent claims 17 and 25 recite limitations similar to those recited in independent claim 1 and discussed above. Therefore, independent claims 17 and 25 are allowable under 35 U.S.C. §103(a) over Natarajan in view of Shah. Furthermore, because all of the dependent claims depending from the independent claims include all the limitations of the respective independent claim from which they ultimately depend, each such dependent claim also is allowable under 35 U.S.C. §103(a) over Natarajan in view of Shah. The Examiner is respectfully requested to withdraw the rejection.

Rejection Under 35 U.S.C. §103

Claims 3-6 and 19-22 and 26-28

Claims 3-6, 19-22 and 26-28 are rejected under 35 U.S.C. §103(a) as being unpatentable over Natarajan in view of Shah in further view of Bertin. The rejection is traversed.

This ground of rejection applies only to dependent claims and is predicated on the validity of the rejection of independent claims 1, 17 and 25 under 35 U.S.C. §103 over Natarajan in view of Shah. Because the rejection of independent claims 1, 17 and 25 under 35 U.S.C. §103 over Natarajan in view of Shah has been overcome, as described hereinabove, and there is no argument put forth by the Office Action that Bertin supplies that which is missing from Natarajan and Shah to render the independent claims unpatentable, this ground of rejection cannot be maintained. The Examiner is respectfully requested to withdraw the rejection.

Newly Added Claims

Dependent claims 29-31 are newly added. These claims depend from claims 1, 13, 17 or 25 and recite additional limitations therefrom. These claims are fully supported by the specification and do not add new matter. These claims limit the term “next network element” to be a “neighboring network element.”

Allowable Subject Matter

Claims 13, 16 and 24

Applicant thanks the Examiner for the allowance of claims 13, 16 and 24. Applicant believes that the record of the prosecution as a whole, including Applicant's specification and claims, provides additional reasons for allowance. The Examiner's Reasons for Allowance do not necessarily state all the reasons for allowance or all the details why the claims are allowed and, therefore, should not be used to interpret the scope of the claims in place of the record of the prosecution as a whole.


Conclusion

It is respectfully submitted that the Office Action's rejections have been overcome and that this application is now in condition for allowance. Reconsideration and allowance are, therefore, respectfully solicited.

If, however, the Examiner still believes that there are unresolved issues, the Examiner is invited to call Eamon Wall at (732) 842-8110 x 120 so that arrangements may be made to discuss and resolve any such issues.

Respectfully submitted,

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